

***Remarks***

Upon entry of the foregoing amendment, claims 9-17, 19-21, and 26 are pending in the application, with claims 9, 13, 19, and 21 being the independent claims. Claims 9, 11-13, 19, 21, and 26 have been amended. Claims 10, 22, and 25 are cancelled. Support for the claim amendments may be found in the original claims and throughout the specification. Thus, no new matter is added by way of these amendments, and their entry is respectfully requested.

Based on the above amendments and the following remarks, Applicants respectfully request that the Examiner reconsider and withdraw the outstanding rejections.

***Claim Rejections Under 35 U.S.C. § 112, first paragraph***

Claims 9-17, 19-21, and 26 were rejected as being non-compliant with the Written Description Requirement of 35 U.S.C. § 112, first paragraph.

To fulfill the written description requirement, a patent specification must describe an invention in sufficient detail that one skilled in the art can clearly conclude that the inventor invented the subject matter claimed. *Regents of the Univ. of Cal. v. Eli Lilly & Co.*, 119 F.3d 1559, 1566 (Fed. Cir. 1997); *Lockwood v. American Airlines*, 107 F.3d 1565, 1572 (Fed. Cir. 1997). The knowledge of one skilled in the art must be considered, and what is conventional or well known to one of ordinary skill in the art need not be disclosed in detail. See *Bilstad v. Wakatopulos*, 386 F.3d 1116, 1126, 72 USPQ2d 1785, 1792 (Fed. Cir. 2004); *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d at 1384, 231 USPQ at 94.

The Office Action states that while the specification does not provide support for a broad genus of compositions and methods where dNTPs are in excess of any degradation component, but the specification does provide support for dNTPs in excess of the degradation component  $Mg^{2+}$ . See Office Action at pages 2-3.

Applicants have amended the present claims to recite compositions, kits, and methods wherein "dNTPs are in excess of  $Mg^{2+}$  or a salt thereof." Support for the amendments may be found in Applicants specification. See the published application US 2004/0152072) at paragraphs 17, 114, 155-158, and 161.

Accordingly, Applicant's Specification is fully compliant with the written description requirement of 35 U.S.C. § 112, first paragraph and Applicants respectfully request that the rejection be withdrawn.

*Claim Rejections Under 35 U.S.C. § 102(b)*

Claims 9-17, 19-21, and 26 were rejected as being anticipated under 35 U.S.C. §102(b) by Schwabe et al.. Applicants respectfully disagree.

An anticipation rejection under 35 U.S.C. § 102 requires a showing that each limitation of a claim is found in a single reference, practice or device. See *Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 771 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984). See also M.P.E.P. 8th ed., § 2131 (rev. 2, May 2004) ("To anticipate a claim, the reference must teach every element of the claim.").

The present claims recite "dNTPs are in excess of  $Mg^{2+}$  or a salt thereof."

Schwabe does not appear to disclose dNTPs in excess of  $Mg^{2+}$  or a salt thereof.

Schwabe teaches a reverse transcription reaction including an excess (10mM) of  $MgCl_2$  over the total concentration of dNTPs (2mM). In Schwabe, the dNTPs clearly are not in excess of  $MgCl_2$ . Accordingly, Schwabe does not anticipate the present claims. Applicants therefore request that this rejection under 35 U.S.C. §102(b) be withdrawn.

Claims 9-17, 19-21, and 26 were rejected as being anticipated under 35 U.S.C. §102(b) by Gerard. Applicants respectfully disagree.

The present claims recite "dNTPs are in excess of  $Mg^{2+}$  or a salt thereof." Gerard does not appear to disclose dNTPs in excess of  $Mg^{2+}$  or a salt thereof. Gerard discloses reverse transcription reactions in which  $MgCl_2$  is in excess of the total concentration of dNTPs by at least 1.5 fold. See Table 3, page 67. Accordingly, Gerard does not anticipate the present claims. Applicants therefore request that this rejection under 35 U.S.C. §102(b) be withdrawn.

Claims 9 and 26 were rejected under 35 U.S.C. §102(b) based upon a public use or sale of the invention as evidence by Gibco. Applicants respectfully disagree.

The claimed kits include a reverse transcriptase and dNTPs that are used in excess of  $Mg^{2+}$  or a salt thereof. The Gibco reference does not disclose kits that include a reverse transcriptase and dNTPs in excess of  $Mg^{2+}$  or a salt thereof. Accordingly, Gibco does not anticipate the present claims. Applicants therefore, request that this rejection under 35 U.S.C. §102(b) be withdrawn.

*Conclusion*

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider and withdraw all presently outstanding objections and rejections. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

Date: November 20, 2006

/Natalie A. Davis/  
Natalie A. Davis  
Reg. No. 53,849  
Agent for Applicants

Invitrogen Corp.  
1600 Faraday Ave.  
Carlsbad, CA 92008  
(760) 268-7469